

### SECTION: REMARKS

This reply is submitted pursuant to 35 U.S.C. §132 and 37 C.F.R. §1.111. The Office Action was carefully considered by the undersigned attorney and applicant. Reconsideration of the application is respectfully requested.

As the Office Action was “Final”, this reply is submitted under the provisions of 37 C.F.R. §1.116. It is believed that the amendment will require only a cursory review by the Examiner and such amendment clearly places the application in a condition for allowance. In the event that the Examiner should not find the application in a condition for allowance, the amendment is believed to remove issues for appeal and should accordingly be entered.

#### **1. Summary of the Office Action.**

Claims 1-2 and 4-7 were pending.

Claims 1-2 and 4-7 stand rejected under 35 U.S.C §112, second paragraph.

Claims 1, 4-5 stand rejected under 35 U.S.C §102(b) over Noga et al (6,112,901)

Claim 2 stands rejected under 35 U.S.C §103(a) over Noga et al in view of Mundt et al (4,685,785)

Claim 6 stands rejected under 35 U.S.C §103(a) over Noga et al in view of Long et al (5,246,107)

Claim 7 stands rejected under 35 U.S.C §103(a) over Noga et al in view of Official Notice.

#### **2. Discussion.**

#### **Claim Rejections - 35 USC §112, Second Paragraph**

Claims 1, 2 and 4-7 were rejected under 35 USC §112, second paragraph. **Claim 1** is amended in response to this rejection. The modified version of Claim 1 introduces the specific changes referred to by the examiner and in addition provides recesses on the frame member. The Examiner indicated that the flanges cannot secure the disk against movement unless the frame member is secured to a back cover. Applicants respectfully point out that the flanges can and do serve to retain a disk against such movement in the absence of a back cover. This is because the frame member is provided with recesses (see recesses 3, 4 in Figure 1) adapted to receive, in use, parts of the periphery of the disk; the flanges serving to restrict disk movement by holding parts of the disk captive in the recesses. References to the presence of the recesses and the functioning of the flanges in conjunction with the recesses to hold the disk against movement, in use, have been added to the claim to clarify the invention. For these reasons, the claim particularly points out and distinctly claims the subject matter which applicants regard as the invention. Withdrawal of the rejection is believed to be in order.

Applicants note that the examiner has made his objection final and may therefore refuse to enter the correction/amendment. However, it is believed that the amendment places the application clearly in order for allowance. Applicants further note that the finality of the rejections appear to relate to the rejections under Section 102 and 103 only. The amendment of claim 1 is made in response only to the rejection under §112, which does not appear to relate to applicants' prior amendment which the examiner stated necessitated his new grounds of rejection.

### **Claim Rejections - 35 USC §102 and 103**

Claims 1, 2, and 4-7 were rejected under 35 USC §102 or 103 as being anticipated by Noga et al or as being obvious in view of Noga et al. alone, or in view of Long et al. or Official Notice. Applicant

asserts that the applied references and Notice do not meet each and every limitation set forth in claim 1 as it stood prior to the amendment described above. There are a number of distinctions between the claimed arrangement of the invention and the arrangements of the applied references. Firstly, Noga et al. relates to a different technology to the present invention, Noga et al. relating, primarily to the storage of integrated circuit (IC) card (such as a PCMIA card) of rectangular shape, not portable disks which, of course, are circular. If the Noga et al. arrangement were to be used in the storage of disks, it is thought that removal of a disk from the arrangement would be difficult as both moveable claws would need to be retracted simultaneously. If the arrangement were modified to use only a pair of diametrically opposed claws, to simplify extraction of a disk, then the disk would probably tend to fall out of the device. Additionally, the action of inserting a disk into the Noga et al. arrangement would require the disk to be tucked beneath the claws 52c, scraped against the claws 52d, and the underside of the disk to scuff over the base of the casing 51. The scrapping and scuffing actions may scratch the data carrying side of the disk and/or apply a delaminating motion to the disk, both of which are clearly undesirable. Of course, where the Noga et al product is used as intended with an IC card, these considerations would not be taken into account.

Further, modification of the Noga et al. product to accept a disk would result in the packing member being too large to fit within a standard size CD case. An object of the Noga et al. case is to provide an arrangement whereby the storage in a standard CD type case can be achieved, modification of the Noga et al. arrangement in this way would not be considered by a person skilled in the art.

As the references relied upon do not describe all of the limitations of claim 1 as it stood prior to amendment, withdrawal of this rejection is believed to be warranted.

The amendment of Claim 1 made to clarify the invention in connection with the rejection under Section 112, second paragraph enclosed herewith further clarified that the frame is provided with recesses (see recesses 3&4 in Figure 1, as mentioned hereinbefore) which, in use, receive parts of the periphery of

the disk. The description on page 4 lines 8 and 9 makes it clear that the flanges and recesses together serve to retain the disk. The retention of the disk in this manner is advantageous in that, apart from the peripheral portions located within the recesses, the underside of the disc does not contact anything and so the risk of damage thereto is reduced. This feature is also not disclosed or suggested by Noga et al. Amended claim 1 is allowable over Noga et al. for this additional reason.

**Claims 2 and 4-7** are all dependent upon claim 1; each such claim adds at least one limitation to the elements of the base claim and is therefore deemed to be allowable with such base and any intervening claim, at least for this reason.

### **3. Conclusion.**

The claims pending after this amendment are believed to be patentable for the reasons stated above. The amendments are believed to be supported by the specification, claims and drawings as filed. It is believed that this case is now in a condition for allowance. Reconsideration and favorable action are respectfully requested.

**Should the Examiner believe that telephone communication would advance the prosecution of this case to finality, he is invited to call at the number below.**

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time under 37 CFR 1.136(a), provided a Petition is not submitted separately.

Please charge any fee due not paid by a check or credit card provided herewith, and/or charge any underpayment in any fee, and/or credit any overpayment in fee, to Deposit Account No. 19-2381.

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TOTAL claims remaining over that previously paid for:	None	\$0
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<u>TOTAL AMOUNT (if any)</u>		\$210
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Respectfully submitted,



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